

REMARKS

The non-final Office action mailed on 3 November 2004 (Paper No. 20041021) has been carefully considered.

Claim 25 is being canceled without prejudice or disclaimer, claims 1, 22, 26 and 32 are being amended, and claim 36 is being added. Thus, claims 1, 4 thru 12, 15 thru 24 and 26 thru 36 are pending in the application.

In paragraph 4 of the Office action, the Examiner rejected claims 1, 4 thru 12, 15 thru 22 and 27 thru 34 under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.*, U.S. Patent No. 6,226,040. In paragraph 6 of the Office action, the Examiner rejected claims 23, 24, 30 and 35 under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040 in view of Suen *et al.*, U.S. Patent No. 6,552,750. In paragraph 7 of the Office action, the Examiner rejected claims 25 and 26 under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040 in view of Kim, U.S. Patent No. 6,473,130. For the reasons stated below, it is submitted that the invention recited in the claims, as now amended, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §103.

In the latter regard, it should be noted that dependent claim 30 is rejected under 35 U.S.C. §102 based on Kuo *et al.* '040 alone, but dependent claim 30 is also rejected under 35 U.S.C. §103 based on Kuo *et al.* '040 combined with Suen *et al.* '750. Clarification as

to the status of claim 30 in the next Office action is requested.

With respect to the rejection of independent claims 1 and 11 under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.* '040, Kuo *et al.* '040 does not disclose a controller which adds a highlight signal to video signals to thereby increase the level of the composed video signals of the highlight portion, and does not disclose a controller which subtracts the highlight signal from the video signals to thereby decrease the level of the composed video signals of the highlight portion, as recited in the penultimate paragraph of claim 1 and in the last paragraph of claim 11. Thus, the current rejection of independent claims 1 and 11 under 35 U.S.C. §102 for alleged anticipation is clearly inappropriate since Kuo *et al.* '040 does not disclose each and every element of claims 1 and 11.

Furthermore, there is nothing within the “four corners” of the disclosure of Kuo *et al.* '040 which would suggest to or instruct a person of ordinary skill in the art as to the necessity or desirability of modifying the disclosure of Kuo *et al.* '040 so as to arrive at the present invention. That is, Kuo *et al.* '040 does not contain any suggestion or instruction which would lead a person of ordinary skill in the art to modify the disclosure of Kuo *et al.* '040 so as to provide the controller with the capability of adding or subtracting a highlight signal to or from video signals in order to increase or decrease the level of the composite video signals of the highlight portion. Thus, a rejection under 35 U.S.C. §103 would also be inappropriate.

With respect to independent claim 1, it should be noted that the claim is being amended herein so as to further distinguish the invention from the prior art cited by the Examiner. Specifically, independent claim 1 is being amended to recite that the displaying part comprises a control key part for controlling a size and a position of the highlight portion, and that the controller comprises an adjuster part for adjusting the picture in response to external signals adjusted by the control key part. The latter recitation further distinguishes the invention of independent claim 1 from the prior art cited by the Examiner since neither Kuo *et al.* '040 nor any of the other references cited in the Office action discloses or suggests the latter feature as now recited in the last paragraph of amended independent claim 1. Thus, for these reasons in addition to the reasons already stated above, the invention of independent claim 1 is distinguishable from the prior art cited by the Examiner.

Based on the above, it is respectfully submitted that independent claims 1 and 11, and their associated dependent claims, recite the invention in a manner distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §102 or §103.

Turning to consideration of independent claim 22, in the Office action (Paragraph 7), dependent claim 25 is rejected under 35 U.S.C. §103 based on the combination of Kuo *et al.* '040 with Kim '130. Moreover, independent claim 22 is being amended to include the recitation of dependent claim 25, which is being canceled.

In formulating the rejection of claim 25 under 35 U.S.C. §103, the Examiner admits that Kuo *et al.* '040 does not disclose an image sharpness part for adjusting a signal size representing a borderline of a highlight portion according to a selection by selection means, and for supplying the adjusted signal size to the signal composing part, as now recited in claim 22.

However, the Examiner alleges that Kim '130 "teaches that the sub-picture display apparatus according to the present invention provides an effect capable of distinctively displaying the sub-picture more definitely and clearly, by thickening the boundary portion of the sub-picture and varying the brightness of the sub-picture to become brighter, in the case that the main picture is complicated spatially or an amount of temporal movement of the main picture is large" (quoting from page 9, lines 13-18 of the Office action). In that regard, the Examiner cites Figure 4 and column 3, line 5 - column 4, line 8 of Kim '130.

However, Figure 4 and the cited portion of Kim '130 merely relate to the functioning of a controller 14 to control a signal processor 13 so that a width of a boundary portion between a main picture and a sub-picture has a predetermined first width which can be discerned between the main picture and the sub-picture (*see* column 3, lines 25-30 of Kim '130). The disclosure of the cited patent also describes how the controller 14 controls the signal process 13 so that the width of the boundary portion between the main picture and the sub-picture becomes a predetermined second width (*see* column 3, lines 36-40 of the patent).

Nevertheless, there is no disclosure or suggestion in Kim '130 of the provision of an image sharpness part for adjusting a signal size presenting a borderline of the highlight portion **according to a selection by selection means**, as recited in amended independent claim 22. Furthermore, there is no instruction as to how one of ordinary skill in the art would modify the disclosure of Kuo *et al.* '040 (specifically, Figure 2 thereof) so as to incorporate an image sharpness part into the controller 231 thereof, or into any other portion of the disclosed arrangement of Kuo *et al.* '040, so as to achieve the results achieved by the display apparatus of claim 22 of the present application. Finally, there is no portion of the primary reference (Kuo *et al.* '040), and the Examiner has not cited any portion thereof, which would motivate or suggest to a person of ordinary skill in the art that the disclosure of Kim '130 should be sought for the purpose of modifying Kuo *et al.* '040 in accordance with the disclosure of Kim '130 in an effort to arrive at the present invention.

Finally, it should be noted that, in this Amendment, independent claim 22 is being further amended to recite that the “signal composing part [is] connected to said highlight signal generating part and to said signal generating means”, and that the “image sharpness part [is] connected between said selection means and said signal composing part” (quoting from the last two paragraphs of amended independent claim 22). These interconnections, as now recited in independent claim 22, are not disclosed or suggested in the prior art cited by the Examiner, thus providing a further basis for distinguishing the invention from the cited

prior art.

For the above reasons, it is submitted that the invention recited in independent claim 22 is distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §102 based on Kuo *et al.* '040, or under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040 in combination with Kim '130.

With respect to the rejection of dependent claim 32 (now in independent form) under 35 U.S.C. §102 based on Kuo *et al.* '040, the Examiner alleges that Kuo *et al.* '040 discloses control means which “further comprises a clock generating part for generating a clock signal to set up a size and a position of the highlight portion” (quoting from page 6 of the Office action). In that regard, the Examiner alleges that the latter feature is “met by the pixel clock which is timing of displaying the further data (Fig. 3, col. 6, line 25 to col. 7, line 67)” (quoting from page 6, last paragraph of the Office action). The Examiner is apparently referring to the OSP signal generator 330 shown in Figure 3 of Kuo *et al.* '040 as receiving a pixel clock input from the displaying signal generator 256 of Figure 2 thereof. However, Kuo *et al.* '040 does not make it clear as to whether or how the pixel clock input provided to the OSP signal generator 330 results in the setting up of a size and a position of a highlight portion, as alleged by the Examiner. Therefore, it cannot be said that Kuo *et al.* '040 discloses or suggests the clock generating part recited in independent claim 32. Thus, for these reasons, a rejection of independent claim 32 under 35 U.S.C. §102 or §103 is clearly

not appropriate.

Dependent claim 33 provides a further basis for distinguishing the invention from the cited prior art in that there is no disclosure or suggestion in Kuo *et al.* '040, or any other reference, of the control means further comprising an adjuster part connected to the clock generating part for receiving a clock signal, and for adjusting a size of the clock signal according to a control signal from selection means. The Examiner alleges (in the first paragraph on page 7 of the Office action) that these elements and functions are met by vertical pixel shift register 404 and horizontal shift register 402, citing column 6, line 25-column 7, line 67 of Kuo *et al.* '040. However, again, it is not clear from the cited patent as to how the shift registers 402 and 404 perform a function of adjusting a size of a clock signal input according to a control signal from selection means, as recited in dependent claim 33.

For the latter reasons, it is submitted that independent claim 32 and associated dependent claim 33 recite the invention in a manner distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §103.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "R. E. Bushnell", is written over a horizontal line.

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